

REMARKS/ARGUMENTS

In the Office Action mailed October 28, 2009 (hereinafter, "Office Action"), claims 1-3, 5, 6, 8-12, 14-20, 22, 23 and 25-27 stand rejected under 35 U.S.C. § 102. Claims 4, 7, 13, 21, and 24 stand rejected under 35 U.S.C. § 103. Claims 1, 11 and 17 have been amended. Claim 28 has been added.

Applicant respectfully responds to the Office Action.

I. Claims 1-3, 5, 6, 8-12, 14-20, 22, 23 and 25-27 Rejected Under 35 U.S.C. § 102(b)

Claims 1-3, 5, 6, 8-12, 14-20, 22, 23 and 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,466,329 to Mukai (hereinafter, "Mukai"). Applicant requests reconsideration in view of the above claim amendments and the following remarks

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987))). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).) In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicant respectfully submits that the claims at issue are patentably distinct from Mukai. Mukai does not disclose all of the subject matter in these claims.

Independent claim 1 has been amended to recite "scanning an image using the scanner to produce scanned image data as part of a scan job" and "obtaining document formatting inputs for the scan job from a user interface... wherein the document formatting inputs comprise copy function options usable with the scan job." (Emphasis added). Claim 1 further recites "encapsulating the scanned image data in a page description language using the document formatting inputs for document formatting... wherein the formatting inputs control how the scanned image data is framed

into a document defined by the page description language.” (Emphasis added). Support for this claim subject matter is found in the originally-filed claim 1 as well as paragraphs [57]-[59] of the specification.

The Office Action appears to suggest that because Mukai has a device with both a scanner and copy functions/inputs that Mukai anticipates the claimed invention. Applicant appreciates this reading of Mukai and has, with this Amendment, attempted to clarify what features distinguish Applicant’s claimed subject matter from Mukai. Applicant’s invention enables a device to “treat a scan job as a copy job with an electronic output instead of paper.” (Specification, at paragraph [67].) For example, “[w]hen the user initiates a scan, the user is able to use the copy functions of the control panel of the imaging device 120 to specify how the image data is to be document formatted.” (Id.) As best understood by Applicant, it does not appear that Mukai allows a user to treat a scan job as a copy job. In contrast, Applicant’s invention provides an “output” that is “identical as if the original operation was a copy job instead of a scan job.” (Specification, paragraph [68]). In other words, the user of the MFP is able to frame a scanned image with the same capabilities “that the user would have if the output would have been paper (i.e., copy job).” (Specification, paragraph [59]).

The Office Action relies extensively on Mukai, col. 9, lines 31-44 and col. 8, lines 14-37 as allegedly teaching claim subject matter regarding receiving formatting inputs from a user interface and “encapsulating” the image data into a page description language. (See Office Action, page 3). Mukai col. 8, lines 14-37 relates to printing. Col. 9, lines 31-44 indicates that a scanned image may be obtained and “enclosed in PDL format.” This section also teaches a “control panel 500” that allows an operator to “input various settings and operation commands copying, printing, facsimile, and document filing operations.” It is significant to note that “scanning” is not mentioned in this list of functions that receive user inputs. Further, Mukai indicates that the operation commands that are input may include the “number of copies, the size of the copies, the degree of enlargement/reduction, duplex printing, and master-page printing, as well as setting of the recipient of a facsimile transmission or file transfer of a document.”

However, such teachings do not satisfy the claim subject matter as amended. Claim 1 explicitly recites that the “document formatting inputs” are “for the scan job” and that such inputs “comprise copy function options usable with the scan job.” Further, the formatting inputs “control how the scanned image data is framed into a document defined by the page description language.” Simply teaching, as Mukai has done, an MFP with scanning functionality and that inputs may be received from a control panel for “copying, printing, facsimile, and document filing operations” does not satisfy this claim subject matter. There is no indication that such inputs relate to copy function options and that such copy function options are used with the scan job, and more specifically, inputs are received as part of the scanning operation that will control how the document is framed into a document. For this reason, this subject matter is allowable over Mukai.

Applicant submits that, in order to reject this claim subject matter as amended, the Office Action would have to show how Mukai teaches the receipt of document formatting inputs used with a scanning function and that such inputs control how the document is framed. Such a disclosure is lacking in Mukai. Mukai appears to indicate that “formatting inputs related to the document [are] inputted by a user utilizing the control panel, [and that] the control panel contains setting and operation commands for copying.” (Office Action, page 3). However, as explained above, the fact that copying inputs may be used with copying does not indicate that such inputs may be used with a scan job or that the user of the MFP is able to frame a scanned image with the same capabilities “that the user would have if the output would have been paper (i.e., copy job).” (Specification, paragraph [59]).

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Mukai. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Mukai does not disclose all of the subject matter of claim 1.

Claims 2-3, 5, 6 and 8-10 depend directly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2-3, 5, 6 and 8-10 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claim 11 has been amended to recite instructions executable to “scan an image using the

scanner to produce scanned image data as part of a scan job.” Claim 11 also recites that the instructions are executable to “obtain document formatting inputs for the scan job from the control panel... wherein the document formatting inputs comprise copy function options usable with the scan job” and that the “formatting inputs control how the scanned image data is framed into a document defined by the page description language.” As discussed above, Mukai does not disclose this claimed subject matter. Accordingly, Applicant respectfully submits that claim 11 is allowable. Claims 12 and 14-16 depend directly from claim 11 and are therefore allowable for at least the same reasons.

Claim 17 has been amended to recite instructions executable to “obtain image data at an imaging device as part of a scan job.” Claim 17 further indicates that the instructions are executable to “obtain document formatting inputs for the scan job from a user interface... wherein the document formatting inputs comprise copy function options usable with the scan job” and that “the formatting inputs control how the scanned image data is framed into a document defined by the page description language.” As discussed above, Mukai does not disclose this claimed subject matter. Accordingly, Applicant respectfully submits that claim 17 is allowable. Claims 18-20, 22, 23 and 25-27 depend either directly or indirectly from claim 17 and are therefore allowable for at least the same reasons.

II. Claims 4 and 21 Rejected Under 35 U.S.C. § 103(a)

Claims 4 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukai in view of U.S. Patent Application Publication No. 2002/0114021 to Lavender et al. (hereinafter, “Lavender”). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, “obviousness requires a suggestion of all

limitations in a claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at **37. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not disclose all of the subject matter in these claims.

Claim 4 depends directly from claim 1. Claim 21 depends indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 4 and 21 be withdrawn.

III. Claims 7, 13 and 24 Rejected Under 35 U.S.C. § 103(a)

Claims 7, 13 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukai in view of U.S. Patent No. 5,493,634 to Bonk et al. (hereinafter, “Bonk”). This rejection is respectfully traversed.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 7 depends directly from claim 1. Claim 13 depends directly from claim 11. Claim 24 depends indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 7, 13 and 24 be withdrawn.

IV. New Claim 28

Claim 28 is a new claim that depends from claim 1 that recites that the “page description language transmitted is identical to that which would have been obtained if the original operation was a copy job instead of a scan job.” Again, as noted above, there is nothing in Mukai that indicates that the scan functionality of Mukai will produce, or is capable of producing, an output that is identical to that which would have been obtained if the operation was a copy job rather than a scan job. Allowance of this claim is respectfully requested.

V. Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: January 28, 2010

AUSTIN RAPP & HARDMAN
170 South Main Street, Suite 735
Salt Lake City, Utah 84101
Telephone: (801) 537-1700